

Ko teaches a pre-wet system for a filter that is used in semiconductor equipment (Abstract). The filtering system disclosed in Ko is generally directed to filtering impurities out of iso-propyl alcohol liquid. The Office Action concedes that Ko does not "expressly disclose the filter accuracy of the second filter to be lower than the filter accuracy of the first filter." The Office Action asserts, however, that Morimoto overcomes the shortfall in the application of Ko to the subject matter of the pending claims. The analysis of the Office Action is unreasonable for at least the following reasons.

Morimoto is directed to a dust excluding mechanism for an image recording apparatus (Abstract). Despite the assertions to the contrary in the Office Action, and as was agreed during the October 28 telephone interview, there is no reasonable manner by which the Office Action can assert that it would have been obvious to one of ordinary skill in the art to have predictably combined the teachings of Ko with the teachings of Morimoto in the manner suggested by the Office Action. There is no manner by which Ko can reasonably be considered to be modified with any teachings of Morimoto with any reasonable expectation of success. The combination of these references would so impermissibly modify Ko as to render the Ko device unsuitable to its intended purpose.

Morimoto is generally directed to electrostatic filters. The totality of the teachings in Morimoto indicate, as is specifically asserted at least at col. 8, lines 52-62, that "the filters 66a and 66b may be selected as appropriate for the environment of use and the characteristics required and, hence, *are not limited in any particular way*, except that the filter 66a (during the replacement of the filter 66b) and the filter 66b (during scanning exposure) should be capable of rejecting those dust particles *in air* which are sufficiently larger than the beam diameters of the laser light beams" (emphasis added). Morimoto goes on to assert that "[i]n the invention, electrostatic filters can be used as the filters 66a and 66b."

Taking the teachings of Morimoto, as a whole, one of ordinary skill in the art would not have reasonably combined Morimoto with Ko in the manner suggested by the Office Action. The filtering system disclosed in Ko is directed to filtering impurities out of iso-propyl alcohol liquid. The systems and methods disclosed in Ko are specifically limited to this purpose. It is not reasonable to assert that one of ordinary skill in the art would have combined, in any manner, a preferably electrostatic filter dust excluding mechanism for an image recording apparatus, as disclosed in Morimoto, with the iso-propyl alcohol filtering system disclosed in Ko with any reasonable expectation of success, or without impermissibly modifying the primary reference to attempt to obtain the subject matter of the pending claims.

It is not as simple a matter as the Office Action suggests to assert that, because a single embodiment of Morimoto may somehow meet the features recited in the pending claims, one of ordinary skill in the art would have predictably combined those teachings in the manner suggested to arrive at the subject matter of the pending claims. Even in a post-KSR analysis, the asserted combination of applied references is simply not reasonable.

The Office Action attempts to legitimize the combination of the applied references by asserting that "[i]n Morimoto et al. clearly when operating properly i.e. the filters are not damaged, any particulate material filtered by the downstream coarse filter 66a would have to have first passed the finer upstream filter 66b and thus be a smaller size than the pore size of the upstream filter 66b and second, agglomerate, congeal, amass, etc. into a particle of larger size so as to be filtered by downstream coarse filter 66a." This assertion totally mischaracterizes the teachings of Morimoto. As quoted above, Morimoto requires that both filters "be capable of rejecting those dust particles in air which are sufficiently larger than the beam diameters of the laser light beams." There is no suggestion of any manner by which any agglomeration, congealing, or amassing may occur in the Morimoto device, nor is that what the filter combination is intended to address. Rather, the filter combination in Morimoto

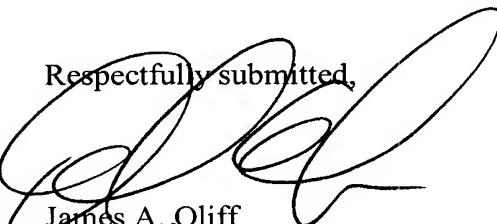
provides permanent down-stream filtering with a filter that need not be often replaced, if at all, to cover at least those instances when a replaceable upstream filter is routinely replaced. As such, the alleged rationale for combining the references in the manner suggested is based on an unreasonable premise that is not supported by the evidence of record.

Applicant's representative presented the totality of the above arguments to Examiners Hepperle and Rost during the October 28 telephone interview. The Examiners conceded that Applicant's representative's arguments had merit. The Examiners indicated that they would further consider Applicant's representative's arguments upon submission of a formal response, but on initial review, the Examiners conceded that these arguments likely traversed the pending prior art rejection of the Office Action.

For at least the foregoing reasons, the combination of Ko with Morimoto is unreasonable. Further, any permissible combination of Ko and Morimoto would not have rendered obvious the combinations of all of the features positively recited in independent claim 1. Further, claims 4, 5, 12 and 13 would not have been rendered obvious by this combination of references for at least the respective dependence of these claims on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 4, 5, 12 and 13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,  
  
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